

Remarks

Claims 1-8 and 22-34 are pending in the subject application. By this Amendment, Applicants have canceled claims 7 and 23, amended claims 1 and 6 and added new claims 35-38. Support for the amendments and new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, Abstract, page 1, paragraph 1 and page 10). Entry and consideration of the amendments and new claims presented herein is respectfully requested. Accordingly, claims 1-6, 8, 22 and 24-38 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Applicants gratefully acknowledge the Examiner's withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of claim 6 from which it is dependent. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of claim 1 from which it is dependent. Applicants have amended claims 1 and 6 to permit interchangeable arrangement of the groups within the general formula claimed. Applicants note the support for said amendment in the specification at page 10, first full paragraph. Accordingly, Applicants have canceled claims 7 and 23 rendering the objection moot.

Claims 1-8 and 22-34 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1 and 6 are indefinite in the recitation of "the peptides labeled in step d)" in part e) as there is insufficient antecedent basis for the peptides labeled in step d), from which it depends. Applicants have amended claims 1 and 6 to provide proper antecedent basis for the "labeled peptides." Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claims 1-6, 8, 22 and 24-34 are rejected under 35 USC §102(b) as anticipated by Aebersold *et al.* (WO 00/11208). The Office Action indicates that Aebersold *et al.* teach a method of identification and quantification of protein in sample by cleaving the protein to peptides using proteolytic enzyme and using a reagent A-L-PRG, wherein A linked to solid support (wherein, A comprises biotin, oligohistidine) and covalently linked to linker L (L contain metal bound chelate and may contain disulfide group, which is cleavable); PRG comprise sulfhydryl group, enzyme

substrate N- hydroxysuccinimide ester groups to bind to the cleaved peptides. Aebersold *et al.* is also cited as teaching the use of tandem technique comprising electrospray ionization Mass spectrometry coupled with liquid chromatography (HPLC/ESI-MS/MS), peptide sequence information combined with isotope and metal-ion chelate tag for qualitative and quantitative analysis of protein in a sample. The Office Action further cites Aebersold *et al.* as teaching the use of chelated metal ion in their L for enhanced ionization in Mass spectrometric analysis. Applicants respectfully assert that the Aebersold *et al.* reference does not anticipate the claimed invention. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) is respectfully requested.

As the Patent Office is aware, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *see also In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (“[R]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.”). More specifically, the prior art reference, in order to anticipate under 35 U.S.C. § 102, must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

In *Net MoneyIN, Inc. v. Verisign, Inc.*, the Federal Circuit addressed the meaning and misconceptions associated with the expression “arranged as in the claim.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008). The Federal Circuit noted the readily understood definition of “arranged as in the claim” when applied to claims that include step-wise addition of elements or ingredients. *Id.* at 1370. Thus, when claims were compared to prior art references that contained all of the elements or ingredients but did not follow the claimed step-wise arrangement, the prior art reference was held to not anticipate the claimed invention. *Id.* However, the Federal Circuit also explained that “arranged as in the claim” is not limited to this narrow “order of limitations” application. *Id.* Instead, the Court requires an anticipatory reference to “show all of the limitations of the claims arranged or combined in the same way as recited in the claims.” *Id.* (emphasis added). The Federal Circuit, in *Net MoneyIN, Inc. v. Verisign, Inc.* (at 1370), provided

descriptive instances of the Court's intended meaning or test in view of prior holdings, for example:

In *Ecocolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed.Cir.2000), we reviewed a district court's decision that a prior art reference directed to "Saving Energy by Catalytic Reduction of Oxygen in Feedwater" anticipated a claim reciting the use of hydrazine with a mixed resin bed to deoxygenate water. In finding that the reference anticipated the claim, the district court considered a figure and accompanying text, which taught the use of hydrogen with a mixed bed to deoxygenate water, in conjunction with a separate passage discussing deoxygenating water with, among other things, hydrazine. *Id.* at 1369. We reversed. After determining that the relevant figure and accompanying text described only the use of hydrogen to deoxygenate water, we concluded that the reference could not anticipate the claimed invention because there was no link between that figure and the general discussion of hydrazine as a deoxygenating agent. *Id.* In other words, we concluded that although the reference taught all elements of the claim, it did not contain a discussion suggesting or linking hydrazine with the mixed bed in the figure, and thus did not show the invention arranged as in the claim.

Applicants respectfully submit that the as-filed claims are not anticipated by Aebersold *et al.* and submit that the disclosure of Aebersold *et al.* does not "show all of the limitations of the claims arranged or combined *in the same way* as recited in the claims." *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008)(emphasis added).

The present invention differs from the disclosure of Aebersold *et al.* in that the claimed method does not utilize isotopically labeled reagents for the identification of labeled peptides (*i.e.*, the reagent of general formula A-Y-PRG is not isotopically labeled). This differs from the disclosure of Aebersold *et al.* where isotopically labeled reagents are used (see, for example, page 11, first full paragraph and claims 1-19) to identify and/or quantify one or more proteins. Indeed, Aebersold *et al.* specifically encourage the comparison of isotopically heavy and light reagents in the exercise of the disclosure (page 11, second paragraph). Thus, it is respectfully submitted that the claims are novel over Aebersold *et al.* and reconsideration and withdrawal of the rejection is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including

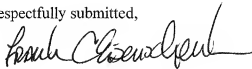
any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



Frank C. Eisenschenk, Ph.D.

Patent Attorney

Registration No. 45,332

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: P.O. Box 142950
Gainesville, FL 32614-2950

FCE/jb